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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,322	11/20/2003	Armin Fehn	WAS 0612 PUS	1060
22045	7590	06/20/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,322

Applicant(s)

FEHN, ARMIN

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 15 is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

Claims 1-14 are objected to because the preamble of claim 1 clearly defines the invention as an organosilicon compound having alkynol moieties yet an embodiment is disclosed wherein "e", which denotes the number of residues containing said alkynol groups, may be zero. In this instance, the compound would obviously be devoid of alkynol groups in disagreement with the early characterization of the invention. Notably, in the absence of units adhering to formula III, there is nothing exceptional about the claimed compound whatsoever. Correction is required.

This issue was raised in the last correspondence but has not yet been addressed by Applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiba et al., U.S. patent # 5,607,992. Claims 10-14 are rejected for the same reason made of record in the Office action dated January 29, 2005. Claims 15-20 are rejected using similar logic while noting that the amounts of component (C) needed to bring about curing inhibition are still so small as to, again, represent nothing more than an impurity in the molded product.

Claims 10-14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cowan, U.S. patent # 4,877,820 for the reasons outlined previously. Claims 10-14 are rejected for the same reason made of record in the Office action dated January 29, 2005. Claims 15-20 are rejected using similar logic while noting that the amounts of component (C) needed to bring about curing inhibition are still so small as to, again, represent nothing more than an impurity in the molded product.

Claims 10-14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tolentino et al., U.S. Patent # 4,382,057. Tolentino discloses the preparation of molded products from the composition outlined in column 3, lines 40-61. The mention of acetylenic alcohols as inhibitors is contemplated in column 11, lines 35-40. Molded products derived from this composition are patentably indistinguishable from those of claims 11-20 for the same reason offered before.

Applicant disputes the Examiner's rejections on the grounds that, although the compositions of the prior art have "overall similarity to compositions not containing the subject invention inhibitors", molded products derived therefrom have different physical properties than do those derived from the compositions of claims 5 through 9. Among the differences alleged by Applicant are less smoothness and less uniform hardness in parts manufactured using the prior art compositions. However, Applicant offers no empirical data in support of their contention. Indeed, the experimental data furnished by the Specification serves only to illustrate differences in the efficacy of the inventive compound (C) as a pot life enhancing agent when compared to inhibitors of the prior art.

Art Unit: 1712

"Arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964).

Applicant might consider providing a declaration under 35 U.S.C. 132 that provides evidence of differences in physical properties between the claimed molded products and those of the prior art. Of course, the experiments should be designed such that the only difference in the makeup of the inventive- and comparative compositions is in the utilization of different inhibitors so as to allow for a proper comparison. Further, Applicant should illustrate that differences are observed even at the lowest limits allowed by claim 12/claim 7.

Insofar as the Examiner has held the claimed molded products to be patentably indistinguishable from even the crosslinkable siloxane compositions devoid of an inhibitor taught by Chiba and Cowan, Applicant must also show that there are differences in properties between the claimed molded products and those in which an inhibitor has not been incorporated.

It is submitted that Applicant could also add new claims directed to a method of making a mold that entails adding the composition of claims 5 to 9 to a mold and reacting the base polymer and crosslinking agent in the presence of components (C) and (D). Methods of making a mold wherein the composition of claim 5 to 9 are used as the mold-making composition are patentable in the Examiner's estimation.

Art Unit: 1712

This Office action will not be made final because the Examiner has applied a new reference that teaches an addition curable silicone composition containing what is believed to be the most structurally analogous inhibitor taught by the prior art.

Claims 3-9 remain allowable and claims 1 and 2 have been rendered allowable in view of Applicant's amendment. New claim 15 is allowable insofar as it is dependent from an allowable claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Zimmer
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AU 1712